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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,320	12/29/2000	Andrew Rouse	LOT920000043US1_8150-0242	6988
53796 7590 01/09/2013 Cuenot, Forsythe & Kim, LLC 12230 Forest Hill Boulevard Suite 120 Wellington, FL 33414				
EXAMINER JAIN, ANKUR				
ART UNIT		PAPER NUMBER		
2649				
NOTIFICATION DATE		DELIVERY MODE		
01/09/2013		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IBMPTOMAIL@iplawpro.com

Office Action Summary**Application No.**

09/750,320

Applicant(s)

ROUSE ET AL.

Examiner

ANKUR JAIN

Art Unit

2649

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2012.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21, 22, 24-30, 32-35 and 37-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21, 22, 24-30, 32-35 and 37-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 38-39 and 41-44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to **claim 38**, the claim is rejected under 35 U.S.C. § 101 because the claim invention is not supported by a process, machine, manufacture, or composition of matter. In the state of the art, transitory signals are commonplace as a medium for transmitting computer instructions and thus, in the absence of any evidence to the contrary and given a broadest reasonable interpretation, the scope of a "storage medium" covers a signal per se. A transitory signal does not fall within the definition of a process, machine, manufacture, or composition of matters. Claim 38 when read in light of Applicant's specification does not define a storage medium to include the disclosed tangible computer readable media, while at the same time excluding the intangible media such as signals, carrier waves, propagated signals, etc, and is thus non-statutory for that reason.

The specification or claims must be amended to limit the storage medium to only non-transitory signals, and state the exclusion of transitory signals (See Official Gazette Notice 1351 OG 212, dated February 23, 2010).

The Examiner suggests amending the claims to state "A non-transitory storage medium..." to overcome the rejection under 35 U.S.C. § 101.

As to **claims 39 and 41-44**, the claims are rejected under 35 U.S.C. § 101 as a result of having a dependency with base claim 38 rejected under 101. Furthermore, these claims do not limit the "storage medium" of claim 38 to exclude the intangible media such as signals, carrier waves, propagated signals, etc, and are all thus non-statutory for that reason. The Examiner suggests correction of these claims as well in order to comply with the 101 requirement.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 21, 22, 25-30, 32-35, 37-39, and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi (US006633759B1) in view of Ulrich et al.

Per claim 21, Kobayashi discloses a method for enabling a wireless client device to communicate with at least one server having one or more applications residing thereon, the method comprising the steps of: enabling the wireless client device (see figure 9, figure 12, and item 2) to select an application residing on the at least one

server (see figure 9 and item 1); enabling the wireless client device to select at least one application action associated with the selected application residing on the at least one server (see column 2 and lines 30-40); executing the at least one selected application action on the at least one server, the application comprising at least one of opening at least one file within the server, closing at least one file within the server, editing at least one file within the server, and searching at least one file within the server (see column 2 and line 49-51). Kobayashi does not teach formatting at least one application output associated with the at least one selected application action based on a profile of the wireless client device and a user selection of more fields associated with the at least one file, transmitting the formatted at least one application output to the wireless client device. Ulrich teaches formatting at least one application output (any attachment or files, see column 12 and lines 57-65) associated with the at least one selected application action (open or add) based on a profile of the wireless client device and a user selection of more fields associated with the at least one file, transmitting the formatted at least one application output to the wireless client device (see column 14 and lines 14-19). Kobayashi also does not teach "the profile of the wireless client device includes a device type of the wireless client device." However, Ulrich teaches "the profile of the wireless client device includes a device type of the wireless client device" (see page 12 1st and 2nd Paragraphs of BPAI Decision of 10/01/2012; and also see Column 12 lines 57-65, Column 14 lines 14-19, and Figures 5A and 6 of Ulrich). With respect to Paragraph 1 of the BPAI Decision, the BPAI has made it very explicit that a "profile including a device type" is non-functional descriptive material that is NOT

given patentable weight. Thus, the Examiner will not give this specific claim limitation patentable weight. This decision from the BPAI is Final and has been made part of the written record. Furthermore, See *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004); see also *Ex parte Nehls*, 88 USPQ2d 1883, 1887-90 (BPAI 2008) (precedential). In such case, according to the BPAI Decision, the Ulrich reference need teach nothing more than a profile containing data, which the Examiner firmly submits is explicitly taught in Column 12 lines 57-65, Column 14 lines 14-19, and Figures 5A and 6 of Ulrich. Furthermore, the BPAI has agreed with the Examiner according to Page 12 Paragraph 2 of the BPAI Decision dated 10/01/2012, that Ulrich is directed to a user setting "profile parameters" (Ans. 9-10; see Ulrich col. 14, 11, 15-19). In support, according to the BPAI Decision, such profile parameters that are understood by a mobile device (*see id.*) teach and suggest the device's profile comprises a feature of the wireless client device. Without this suggestion, the parameters would not be understood by the mobile device.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the references to properly forward attachment to the destination with compatibility.

Per claim 28, Kobayashi discloses a wireless communication system comprising:

- a server having one or more application thereon (see column 8 and lines 47-51); a
- wireless client device comprising: a views/folders module that enables the wireless client device to display options associated with a selected application residing on the server (column 9 and lines 40-49); a default and custom actions module that enables

the wireless client device to select an application action associated with the selected application to be executed on the server, the application action comprising at least one of opening at least one file within the server, closing at least one file within the server, editing at least one file within the server, and searching at least one file within the server; and a forms module that enables the wireless client device to view at least one application output associated with the at least one selected application action (see column 10 and lines 52-64). Kobayashi does not teach formatting at least one application output associated with the selected application action based on a profile of the wireless client and a user selection of more fields associated with the at least one file, transmitting the formatted at least one application output to the wireless client device. Unrich teaches formatting at least one application output associated with the at least one selected application action based on a profile of the wireless client device and a user selection of more fields associated with the at least one file, transmitting the formatted at least one application output to the wireless client device (see column 14 and lines 14-19). Kobayashi also does not teach "the profile of the wireless client device includes a device type of the wireless client device." However, Ulrich teaches "the profile of the wireless client device includes a device type of the wireless client device" (see page 12 1st and 2nd Paragraphs of BPAI Decision of 10/01/2012; and also see Column 12 lines 57-65, Column 14 lines 14-19, and Figures 5A and 6 of Ulrich). With respect to Paragraph 1 of the BPAI Decision, the BPAI has made it very explicit that a "profile including a device type" is non-functional descriptive material that is NOT given patentable weight. Thus, the Examiner will not give this specific claim limitation

patentable weight. This decision from the BPAI is Final and has been made part of the written record. Furthermore, See *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004); see also *Ex parte Nehls*, 88 USPQ2d 1883, 1887-90 (BPAI 2008) (precedential). In such case, according to the BPAI Decision, the Ulrich reference need teach nothing more than a profile containing data, which the Examiner firmly submits is explicitly taught in Column 12 lines 57-65, Column 14 lines 14-19, and Figures 5A and 6 of Ulrich. Furthermore, the BPAI has agreed with the Examiner according to Page 12 Paragraph 2 of the BPAI Decision dated 10/01/2012, that Ulrich is directed to a user setting "profile parameters" (Ans. 9-10; see Ulrich col. 14, 11, 15-19). In support, according to the BPAI Decision, such profile parameters that are understood by a mobile device (*see id.*) teach and suggest the device's profile comprises a feature of the wireless client device. Without this suggestion, the parameters would not be understood by the mobile device.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the references to properly forward attachment to the destination with compatibility.

Same arguments apply, mutatis mutandis, to independent claims 33 and 38.

Per claims 22, Kobayashi further teaches that the user would be able to select at least one application such as email software (see column 4 and lines 35-38).

Same arguments apply, mutatis mutandis, to claims 32 and 37.

Per claims 25, 42, Ulrich further teaches the at least one feature of the wireless client device includes one or both of an input interface feature (number of objects), and a data processing feature (see column 14 and lines 50-60).

Per claim 26, 43, Kobayashi further teaches altering the object or artifact contained in the at least one application output separate from other information included in the at least one application output, the object or artifact (see column 8 and lines 64-67, only job result to be sent) being altered to reduce an amount of information that the object or artifact contains (column 10 and line 65-column 11 and line 10).

Per claim 27, 44, Kobayashi further teaches that the wireless client device includes at least one of a data-capable wireless phone, an interactive pager, and a personal digital assistant (see figure 9). The examiner takes an "Office Notice" that it is notoriously well known in the art to indicate the type of mobile device within the profile that is forwarded to another device so the another device could identify which device has been connected. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the type information of wireless device such that the receiving side is easy to identify when there is more than one device for connection. .

Per claims 29, 30, 34, 35, 39, Kobayashi further teaches that a customization module that enables the wireless client device to customize at least one view of the at least one application output wherein inherently the customization module further enables the wireless client device to customize at least one of a display language, a time zone, a date format, and a font format (see column 11 and lines 4-23).

Claims 24 and 41 rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi (US006633759B1) and Ulrich et al in further view of Criss et al (US006308061B1).

Kobayashi does disclose an analogous art as recited in claim 21 and 38. Kobayashi doesn't expressly teach that the profile of the wireless device includes at least one feature of the wireless client device. Criss teaches that the version number, and capacity, etc. of wireless device are transmit to a host computer for keep up with the upgrade of the wireless device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Criss with Kobayashi's system to reduce redundancy of upgrade by pre-verifying the feature and capacity of the wireless device.

Response to Arguments

Applicant's arguments filed November 30th, 2012 have been fully considered but they are NOT persuasive.

As a preliminary comment, the Examiner suggests Applicant amend the claims to clarify Applicant's invention in order to advance prosecution and advance towards allowance.

With respect to the Pages 11-13 of the Remarks, the Examiner firmly submits that Kobayashi discloses a wireless communication system comprising: a server having one or more application thereon (see column 8 and lines 47-51); a wireless client device comprising: a views/folders module that enables the wireless client device to display

options associated with a selected application residing on the server (column 9 and lines 40-49); a default and custom actions module that enables the wireless client device to select an application action associated with the selected application to be executed on the server, the application action comprising at least one of opening at least one file within the server, closing at least one file within the server, editing at least one file within the server, and searching at least one file within the server; and a forms module that enables the wireless client device to view at least one application output associated with the at least one selected application action (see column 10 and lines 52-64). Kobayashi does not teach formatting at least one application output associated with the selected application action based on a profile of the wireless client and a user selection of more fields associated with the at least one file, transmitting the formatted at least one application output to the wireless client device. Ulrich teaches formatting at least one application output associated with the at least one selected application action based on a profile of the wireless client device and a user selection of more fields associated with the at least one file, transmitting the formatted at least one application output to the wireless client device (see column 14 and lines 14-19). Kobayashi also does not teach “the profile of the wireless client device includes a device type of the wireless client device.” However, Ulrich teaches “the profile of the wireless client device includes a device type of the wireless client device” (see page 12 1st and 2nd Paragraphs of BPAI Decision of 10/01/2012; and also see Column 12 lines 57-65, Column 14 lines 14-19, and Figures 5A and 6 of Ulrich). With respect to Paragraph 1 of the BPAI Decision, the BPAI has made it very explicit that a “profile including a device

type" is non-functional descriptive material that is NOT given patentable weight. Thus, the Examiner will not give this specific claim limitation patentable weight. This decision from the BPAI is Final and has been made part of the written record. Furthermore, See *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004); see also *Ex parte Nehls*, 88 USPQ2d 1883, 1887-90 (BPAI 2008) (precedential). In such case, according to the BPAI Decision, the Ulrich reference need teach nothing more than a profile containing data, which the Examiner firmly submits is explicitly taught in Column 12 lines 57-65, Column 14 lines 14-19, and Figures 5A and 6 of Ulrich. Furthermore, the BPAI has agreed with the Examiner according to Page 12 Paragraph 2 of the BPAI Decision dated 10/01/2012, that Ulrich is directed to a user setting "profile parameters" (Ans. 9-10; see Ulrich col. 14, 11, 15-19). In support, according to the BPAI Decision, such profile parameters that are understood by a mobile device (see *id.*) teach and suggest the device's profile comprises a feature of the wireless client device. Without this suggestion, the parameters would not be understood by the mobile device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the references to properly forward attachment to the destination with compatibility.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANKUR JAIN whose telephone number is (571)272-9747. The examiner can normally be reached on M-F, 9:00 am to 4:00 pm, EST.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ankur Jain/

Examiner, Art Unit 2649

/Yuwen Pan/

Supervisory Patent Examiner, Art Unit 2649